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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/510,410	10/06/2004	Reddy Bandi Parthasardhi	H1089/20019	8531
3000 7590 01/17/2008 CAESAR, RIVISE, BERNSTEIN, COHEN & POKOTILOW, LTD. 11TH FLOOR, SEVEN PENN CENTER 1635 MARKET STREET PHILADELPHIA, PA 19103-2212			EXAMINER CHANG, CELIA C	
			ART UNIT 1625	PAPER NUMBER
			NOTIFICATION DATE 01/17/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents@crbcp.com

Office Action Summary	Application No. 10/510,410	Applicant(s) PARTHASARDHI ET AL.	
	Examiner Celia Chang	Art Unit 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 1-3, 5-10, 14.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-10 and 14 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-10, 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Amendment and response filed by applicants dated Nov. 2, 2007 have been entered and considered carefully. Claims 4, 11-13 have been canceled. Claim 14 has been added. Claims 1-3, 5-10, and 14 are pending.

2. The rejection of claims 1-2, 4-6, 8-10 under 35 USC 102(b) over US 4,357,337 is maintained for reason of record.

Applicants argued that the amendment of inserting hydrogenation in a solvent and limiting the acid to 0.1-10 mole per mole of compound would obviate the rejection. Please note that acetic acid can be a solvent when the term solvent is interpreted in the broadest sense without limitation. Applicants have calculated that the acetic acid in the prior art is 37 moles, therefore, 0.10 moles serves as catalyst, 36.9-27 moles serves as solvents. Thus, the amendment did not obviate the anticipation.

3. The rejection of claims 1-12 under 35 USC 102(e) over US 6,649,765 is maintained for claims 1-3, 5-6, 8-10.

To the extent that the claims read on unlimited solvents and acids, anticipation is maintained. Please note that applicants' argument to obviate the prior art is that the prior art starting material is different as delineated by applicants on page 7 formula A of the response. Please note that the prior art starting material has a "methylene" linker which is not formula A which has a triple bond linker. The prior art anticipated the claims since the claims read on unlimited solvents and acids included those of the prior art.

Even if the compound is as delineated by applicants' formula A, claims 11-3, 5-10 and 14 would be rejected under 35 USC 103(a) over US 6,649,765 in view of Iimura '081 which will be maintained as following.

The compound delineated as formula A on page 7 of the response would be a precursor for the instant starting material since the triple bonded carbon linker would be hydrogenated, then the unsaturated carbons of aromatic pyridine will be hydrogenated in a stepwise manner. This rationale is supported by the flow description of Iimura '81 col.6, lines 45-65 wherein

functional group other than the pyridinyl ring would be reduced before the aromatic pyridinyl ring is reduced. Per ponderous of evidence in the art supports this stepwise reaction (see also Dubroeuq '337 col. 15 preparation (2)). The instant step is a sequence of the prior art continuous process which is prima facie obvious in absence of unexpected results. In re Fong 154 USPQ 25, 27; In re Dillon 13 USPQ2d 1337.

Claims 7 and 14 as now amended are rejected under 35 USC 103(a) because the specific acid or solvents are prima facie picking and choosing of effect oriented parameters i.e. optimization, routinely practiced by chemists. In re Boesch 105 USPQ 215.

4. The rejection of claims 1-12 under 35 USC 103(a) over Dubroeuq et al. '337 or Vidyadhar et al. '765 in view of Iimura '081 is maintained for claims 1-3, 5-10 and 14 as now amended.

The Iimura '081 reference disclosed Y is nonhydrogen compounds being similarly in activity which is an implicit suggestion to persons having ordinary skill in the art that analogous compounds such as Y is F would be expected to have similar activity. Therefore, the process, the similarity and successful expectation provided by the references would motivate one having ordinary skill to employ the Y is F material in a process operable for Y is H with the expectation that similar result would be expected.

The arguments that the instant process is operable over the prior art because different parameters such as specific acid, specific solvents or specific acid/compound ratio are employed, must be supported by factual evidence and claims in scope commensurate with the operable limitation. Were applicants argued that acetic acid and methanol such as disclosed in prior art are not operable, then applicants are raising a 112 1st paragraph issue since acetic acid was find in claim 6 and methanol in claim 14. Were applicants argued that the difference is mere by degree in the particular ratio, then, such unexpected result was not presented by a side by side comparison using the Y is F compounds.

5. Applicants amendment necessitated the new grounds of rejections.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celia Chang, Ph. D. whose telephone number is 571-272-0679. The examiner can normally be reached on Monday through Thursday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet L. Andres, Ph. D., can be reached on 571-272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

OACS/Chang
Jan. 9, 2008


Celia Chang
Primary Examiner
Art Unit 1625